

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed November 3, 2004 (“*Office Action*”). Claims 1-30, 31-34, 36-39, and 41 were pending in the Application and stand rejected. Applicants amend Claims 31, 36, and 41 to clarify the original intent of these claims. Applicants respectfully request reconsideration and favorable action in this case.

Section 103 Rejections

The Examiner rejects Claims 1-30, 31-34, 36-39, and 41 under 35 U.S.C. § 103(a) as being unpatentable over various combinations of references. To establish a *prima facie* case of obviousness of a claimed invention under § 103, all claim limitations must be taught or suggested by the prior art. M.P.E.P. § 2143.03. Furthermore, the Examiner must point to some teaching, suggestion, or motivation to combine or modify the teachings of the prior art to produce the claimed invention either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art at the time of the invention. *Id.* § 2143.01.

The M.P.E.P. sets forth a strict legal standard for combining or modifying references. According to the M.P.E.P., “[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art” at the time of the invention. M.P.E.P. § 2143.01. “The mere fact that references can be combined or modified does not render the resultant combination [or modification] obvious unless the prior art also suggests the desirability of the combination” or modification. *Id.* (emphasis in original).

Governing Federal Circuit case law makes this strict legal standard even clearer. According to the Federal Circuit, “a showing of a suggestion, teaching, or motivation . . . is an ‘essential component of an obviousness holding.’” *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000) (quoting *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998)). Furthermore, while “evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to

be solved, [t]he range of sources available . . . does not diminish the requirement for actual evidence.” *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Thus, it is a factual question that cannot be resolved on subjective belief and unknown authority, but must be based on objective evidence of record. *See In re Lee*, 277 F.3d 1338, 1343-44 (Fed. Cir. 2002). Indeed, the factual inquiry whether to combine or modify references must be thorough and searching. *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52 (Fed. Cir. 2001).

Claims 31-34, 36-39, and 41

***The Dalal-Baker Combination Fails to Teach or Suggest All
Elements of Claims 31-34, 36-39, and 41***

The Examiner rejects Claims 31-34, 36-39, and 41 under 35 U.S.C. § 103(e) as being unpatentable over U.S. Patent No. 6,633,554, which issued to Dalal (“*Dalal*”), in view of U.S. Patent No. 6,459,725, which issued to Baker, et al. (“*Baker*”).

Applicants’ independent Claim 31, as amended, recites:

A method for communicating with wireless devices,
comprising:

initiating a communication session between a wireless
communication device and a first wireless base station coupled
to a local area network (LAN) having an ethernet
communication pathway;

repeating signals from the wireless communication
device to increase a range of the first wireless base station;

negotiating a handoff of the communication session
from the first wireless base station to a second wireless base
station using the ethernet communication pathway based on
increased ranges of the wireless base stations when the signals
from the wireless communication device are being repeated;
and

handing off the communication session from the first
wireless base station to the second wireless base station.

Applicants respectfully submit that *Dalal* and *Baker*, whether taken alone or in combination, fail to teach or suggest every element of this claim.

Among other aspects of Claim 31, the *Dalal-Baker* combination fails to teach or suggest “initiating a communication session between a wireless communication device and a first wireless base station coupled to a local area network (LAN) having an ethernet communication pathway.” As teaching this element, the Examiner cites to *Dalal*’s discussion of a communications line connecting base stations and a mobile switching center (MSC).

Office Action, page 2 (citing *Dalal*, col. 5, lines 22-30 and Figure 1). However, a communications line connecting base stations and an MSC fails to teach or suggest “initiating a communication session between a wireless communication device and a first wireless base station coupled to a local area network (LAN) having an ethernet communication pathway.” Similarly, *Baker* fails to teach or suggest these aspects. Therefore, Applicants respectfully submit that *Baker* fails to remedy the shortcomings of *Dalal*.

For at least these reasons, Applicants respectfully submit that *Dalal* and *Baker* fail to teach or suggest each and every element of independent Claim 31. For analogous reasons, Applicants respectfully submit that *Dalal* and *Baker* fail to teach or suggest each and every element of independent Claims 36 and 41. Thus, for at least these reasons, Applicants respectfully request the Examiner to reconsider and withdraw the rejection of independent Claims 31, 36, and 41 as well as their respective dependent claims.

The Proposed Combination of Dalal and Baker Is Improper

Furthermore, Applicants respectfully submit that Claims 31-34, 36-39, and 41 are patentable over *Dalal* and *Baker* because there is no teaching, suggestion, or motivation to combine or modify the teachings of *Dalal* and *Baker* either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

In the present case, the *Office Action* has not cited any evidence of a teaching, suggestion, or motivation to combine or modify the teachings of *Dalal* and *Baker*. Instead, the Examiner has merely stated that the teachings of one reference would improve the teachings of another reference. Consider the *Office Action*’s only statement with regard to the combination of *Dalal* and *Baker*:

Therefore, it would have been obvious to one having ordinary skill in the art to have the feature of having the device used for repeating signals to increase a range of a wireless base station to avoid the loss of signals due to the distant [sic] of the wireless base station.

Office Action, page 3.

Applicants respectfully submit that this statement does not provide the required evidence of a teaching, suggestion, or motivation to combine or modify the references. This statement represents the subjective belief of the Examiner, does not point to any known authority, and therefore is not based on objective evidence of record. Thus, the Examiner has not provided any evidence of a teaching, suggestion, or motivation to combine or modify the

references, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. At least for this reason, Applicants respectfully submit that Claims 31-34, 36-39, and 41 are allowable over the cited references.

Claims 1-30

The Proposed Combination of Sayers, Dalal, and Baker Is Improper

The Examiner rejects Claims 1-30 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,542,754, which issued to Sayers, et al. ("*Sayers*"), in view of *Dalal* and *Baker*. Applicants respectfully submit that Claims 1-30 are patentable over *Sayers* in view of *Dalal* and *Baker* because there is no teaching, suggestion, or motivation to combine or modify the teachings of *Sayers*, *Dalal*, and *Baker* either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

In the present case, the *Office Action* has not cited any evidence of a teaching, suggestion, or motivation to combine or modify the teachings of *Sayers*, *Dalal*, and *Baker*. Instead, the Examiner has merely stated that the teachings of one reference would improve the teachings of another reference. Consider the *Office Action*'s only statement with regard to the combination of *Sayers*, *Dalal*, and *Baker*:

Therefore, it would have been obvious to one having ordinary skill in the art to have the feature of the plurality of repeaters coupled to the communication back-bond [sic] to help increasing [sic] a range of the wireless base station to avoid the loss of signals due to the distant [sic] of the wireless base stations.

Office Action, page 5.

Applicants respectfully submit that this statement does not provide the required evidence of a teaching, suggestion, or motivation to combine or modify the references. This statement represents the subjective belief of the Examiner, does not point to any known authority, and therefore is not based on objective evidence of record. Thus, the Examiner has not provided any evidence of a teaching, suggestion, or motivation to combine or modify the references, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. At least for this reason, Applicants respectfully submit that Claims 1-30 are allowable over the cited references.

**The Sayers-Dalal-Baker Combination Fails to Teach or Suggest All
Elements of Various Dependent Claims**

The Examiner has not cited to any portion of *Sayers*, *Dalal*, or *Baker* that teaches or suggests the elements included in various dependent claims. For example, consider dependent Claims 6-8. For these claims, Applicants respectfully submit that the Examiner cites portions of *Sayers* that fail to teach or suggest the claim language.

First, consider Claim 6, which provides:

The system of Claim 1, wherein said wireless internet server includes a wireless mobility module for managing mobile units within the system.

As teaching the elements of Claim 6, the Examiner cites the following portion of *Sayers*:

. . . communicating through the P-BTSs 27 in the private networks 14 have access to the terminals 21 in LANs 24 and have access to the public networks 8. Further, the P-BTSs 27 in the private wireless networks 14 have available higher data rates than those available through the BTSs 12 in the public wireless network 15. In the example described in the present specification, private rates up to 384 kbps or higher are possible whereas conventional public cellular networks currently only provide rates up to 64 kbps. Accordingly, data retrieval operations in the private networks 14 are better accommodated than in the public wireless network 15 of . . .

Sayers, Col. 10, lines 10-20. Applicants respectfully submit that the cited language fails to teach or suggest any aspects of the claim language.

Next, consider Claim 7, which provides:

The system of Claim 1, wherein said wireless internet server provides real-time call processing.

As teaching the elements of Claim 7, the Examiner cites the following portion of *Sayers*:

. . . accommodated than in the public wireless network 15 of FIG. 1.

In FIG. 1, the wireless P-BTS 27 directly connect [sic] the mobile stations 4 through connection unit 23 to other facilities in private networks 14 and thereby permit, for example, the mobile stations 4 to send and receive calls to . . .

Sayers, Col. 10, lines 20-25. Again, Applicants respectfully submit that the cited language fails to teach or suggest any aspects of the claim language.

Last, consider Claim 8, which provides:

The system of Claim 5, said wireless internet server includes an integrated base station controller module and a mobile switch controller module for managing calls between communication units within the system.

As teaching the elements of Claim 8, the Examiner cites the following portion of *Sayers*:

Synchronization Redundancy

GPS interface to OAM. Each radio interfaces to the Network Management System via a standard SNMP interface across the network. It is through this interface that the GPS synchronisation card communicates with the OAM system, informing it of its condition, current synchronisation reference, and request for synchronisation reclassification. This scheme is also used to set up slave units and indicate all the possible master P-BTS units that could be used to potentially synchronise their crystal source.

Maximum SCH rebroadcast hops. Each slave P-BTS unit may only "listen" to a GPS synchronised reference. A slave P-BTS accepting a rebroadcast GPS source may not broadcast signals on the BCCH indicating it is a master P-BTS synchronising source. This should prevent "a copy of a copy" from being used. If a slave unit was used to synchronise a slave unit then it is likely that the frequency errors would accumulate meaning that the receiving slave may incorrectly set its crystal frequency out of specification.

System configuration and guidelines. Each P-BTS can be individually configured to acquire synchronization from a preferred source. Normally, each P-BTS may be presented with multiple master clock sources that include network card references (E1/T1, xDSL, ISDN), primary port, secondary port, internal oscillator, GPS reference, SCH reference and 10/100BaseT reference.

The system administrator can rank order these master clock sources in priority. This priority scheme must also be configured to explicitly define the number of times the P-BTS can move to another synchronisation reference within a specified period of time, reporting this to the centralized network management system. This prevents the system from looping through endlessly should a series of deficient sources impact the network.

Signal Processor and Radio Frequency Analyzer--FIG. 9

FIG. 9 is a block diagram representation of a transmit/receive signal processor 6-27, a radio frequency analyzer 9-0, Ethernet driver 9-20 and a P-BTS processor 9-30 employed in the

private wireless base stations (P-BTS) 27 of FIG. 1, FIG. 2 and FIG. 3.

Sayers, Col. 16, lines 10-50. Again, Applicants respectfully submit that the cited language fails to teach or suggest any aspects of the claim language.

Furthermore, Applicants respectfully submit that the addition of *Dalal* and *Baker* fails to provide the elements of Claims 6-8 not taught by *Sayers*. Thus, for these additional reasons, Applicants respectfully request the Examiner to reconsider and withdraw the rejection of Claims 6-8.

Conclusions

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending Claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

Although no fee is believed to be currently due, the Commissioner is hereby authorized to charge any fee or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorneys for Applicants



Kurt M. Pankratz
Reg. No. 46,977

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CORRESPONDENCE ADDRESS:

2001 Ross Avenue
Dallas, Texas 75201-2980
Tel. 214.953.6584; Fax. 214.661.4584

Customer PTO ID No. **05073**